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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,114	11/13/2001	Tomoaki Nagano	B-4384 619300-5	3430
36716	7590	12/07/2005	EXAMINER	
LADAS & PARRY 5670 WILSHIRE BOULEVARD, SUITE 2100 LOS ANGELES, CA 90036-5679			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,114

Applicant(s)

NAGANO ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The Applicant amended claims 1-5 and 7-11, and canceled claim 6. All pending claims 1-5 and 7-11 were examined in this final office action.

Response to Arguments

Pertaining to Rejection under 35 USC 102 in previous office action

Applicant's arguments filed 23 September 2005 have been fully considered but they are not persuasive. Stefik teaches a requester using the process to change the contents of the digital work as desired. Example by Stefik: it can select and duplicate parts of it; combine it with other information; or compute functions based on the information. This can amount to editing text, music, or pictures or taking whatever other steps are useful in creating a derivative work) (see col. 41, lines 7-13).

Pertaining to Official Notice

The Applicant did not traverse the examiner's assertion of official notice. The common knowledge or well-known in the art statement is taken to be admitted prior art because applicant failed to traverse or adequately traverse the examiner's assertion of official notice (MPEP 2144.03(C)).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one-year prior to the date of application for patent in the United States.

1. **Claims 1-4 and 7- 11 are rejected under 35 USC 102(b) as being anticipated by Stefik (Paper #20050620, US 5,629,980).**

Stefik teaches all the limitations of claims 1-4 and 6-11; For example, Stefik discloses the creation or new digital works, creation of derivative digital works, editing digital works, managing and distributing digital works, and selling of digital works. Stefik discloses usage rights management of digital works (please note examiner's interpretation: creature data is a digital work) (please see at least abstract; col. 3, line 50 through col. 4, line 36). Stefik further discloses:

- Registering digital content: Inherent in Stefik are the structures necessary to permit a digital work creator to register the created digital work for distribution. For example, creating and storing created digital work in a repository (see at least Fig. 1 (101, 102); col. 7, lines 6-11).
- Editing material: a user creating a derivative (see at least col. 6, lines 10-12; col. 40, line 47 through col. 41, line 39).
- Selling process: selling original digital works or derivative works created and edited for purpose of creating a product item for presentation and

selling (see at least col. 6, lines 1-20; col. 43, line 45 through col. 44, line 22; col. 44, line 23 through col. 49, line 39).

- Digital works: movies, music, video games (please note examiner's interpretation: still or animated creatures), audio recordings, text, pictures, books, documents (see at least col. 3, lines 51-61; col. 19, lines 50-55).
- Combining editing data: a requester uses the process to change the contents of the digital work as desired. Example by Stefik: it can select and duplicate parts of it; combine it with other information; or compute functions based on the information. This can amount to editing text, music, or pictures or taking whatever other steps are useful in creating a derivative work) (see col. 41, lines 7-13).

Pertaining to system and apparatus claims 1-4 and 7-9

Rejection of claims 1-4 and 7-9 is based on the same rationale as noted above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2. Claim 5 is rejected under 35 USC 103(a) as being unpatentable over Stefik (Paper #20050620, US 5,629,980) in view of Official Notice (Paper #20050620, admitted prior art regarding old and well-known).**

Stefik teaches all the above as noted under the 102(b) rejection and teaches a system and method for creating, editing, and distributing digital works including, but not limited to, movies, music, video games, audio recordings, text, pictures, books, and documents, and further teaches or suggests still or animated characters as found in video games. Stefik, however, does not specifically disclose creature data in 2-dimensions or 3-dimensions. The Examiner takes the position that it is old and well-known in the art to depict things in 2-dimensional and/or 3-dimensional renderings. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Stefik to disclose digital works in 2-dimension and/or 3-dimensions as taught by Official Notice, in order to fully disclose old and well-known prior art teachings, and thereby attract digital works creators wanting to distribute 2-dimensional and/or 3-dimensional digital works.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert M. Pond
Primary Examiner
December 1, 2005